## REMARKS

Claims 1-23 have been examined in the present Office action. The Examiner states that claims 5-7 and 10-14 are in condition of allowance. Claims 1-4, 8, 9, and 15-20 are rejected under 35 U.S.C. § 103(a) and claims 21-23 are objected to as being dependent upon rejected claims. The rejection is addressed below.

Rejection under 35 U.S.C. § 103(a)

Claims 1-4, 8, 9, and 15-20 are rejected under 35 U.S.C. § 103(a) as being obvious over Caine *et al.* (Caine et al., *Neuroreport* (1997) 8: 2373-7; hereinafter "Caine") and over Kutter *et al.* (EP 417, 637 A2; hereinafter "Kutter").

Claim 1, from which claims 2 and 3 depend, and claim 4, from which claims 8 and 9 depend, are directed to the administration of pramipexole in a dose ranging from 1.5 mg/day to 6.0 mg/day for treating a human patient having a stimulant dependency or cocaine craving, respectively. Claim 15, from which claims 16, 17, and 19-23 depend, and claim 18, from which claims 19-23 depend, are directed to the intranasal administration of pramipexole for the treatment of a human patient having a stimulant dependency or cocaine craving, respectively.

Turning to the first cited reference, the Office asserts that Caine, in teaching that the administration of pramipexole decreases the self-administration of cocaine, differs from the present invention only in the "specific range of dosages, modes, and methods of administration." Further citing Kutter, the Office states that pramipexole (SND 919) is

disclosed as being effective in the treatment of drug dependence mediated by dopamine release. Relying on each of these references independently, the Examiner concludes that one skilled in the art would have been motivated to determine the optimum amount and mode of administration, including nasal administration, and would thereby arrive at the claimed invention. For the reasons outlined below, Applicant respectfully traverses this rejection.

The standard for a *prima facie* case of obviousness is clearly set forth in MPEP § 2143.03, which states (emphasis added):

> To establish a *prima facie* case obviousness of a claimed invention, *all the claim limitations* must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)

To this end, Applicant submits that, as is acknowledged by the Office, neither of the two cited references discloses all the limitations of the present claims. With respect to claims 15 and 18, and their dependent claims, neither Caine nor Kutter teach the *intranasal* administration of pramipexole. While Kutter discloses administering the drug orally, parentally, and rectally, the intranasal administration of pramipexole is neither taught nor suggested. This is significant as Kutter clearly contemplated a number of alternative routes for pramipexole administration, but does not suggest that the compound might be delivered *intranasally*, as required by Applicant's claims. Similarly, Caine teaches only sub-cutaneous administration of pramipexole (see Figure 2A in Caine), once again demonstrating a failure to contemplate or suggest administration of pramipexole by

an intranasal route.

In view of the deficiencies in the references, Kutter and Caine, rather than suggesting Applicant's invention of claims 15 and 18, actually highlight its nonobviousness. Nowhere in either of these references - both of which focus on pramipexole and its administration - is intranasal administration of the compound suggested or even hinted at; nor is the desirability of such intranasal administration discussed.

Similarly, claims 1 and 4 are directed to the administration of pramipexole at a very specific dose ranging from 1.5 mg/day to 6.0 mg/day. In contrast, Kutter and Caine both disclose administering this drug at a significantly lower dose. Kutter teaches administering pramipexole at a daily dose ranging between 0.025 mg to 0.750 mg, while Caine teaches administering pramipexole at various doses, the highest being less than 10 μmol (~0.7 mg/day). Thus, neither Kutter nor Caine provide, by teaching or suggestion, the specific dosage limitation found in claims 1 and 4.

On the issue of nonobviousness, Applicant further points out that the Office cannot provide by "the level of skill in the art" what is clearly missing from the references. Applicant directs the Office's attention to the recent Federal Circuit decision in *In re Sang Su Lee*, 277 F.3d 1338, 1342 (Fed. Circ. 2002), which shares facts with the present case. The invention claimed by Lee encompassed a method of automatically displaying the functions of a video display device and demonstrating how to select and adjust the function in order to facilitate response by the user. Both the Office and the Board of Patent Appeals

and Interferences stated that the invention was obvious in view of the prior art given that "the demonstration mode is just a programmable feature which can be used in many device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial." The Federal Circuit, in reversing this decision and holding that the claimed invention was not obvious in view of the prior art, noted that such reasoning was flawed, stating (emphasis added):

> This factual question of motivation is material to patentability, and *could not be resolved on subjective belief and unknown authority*. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W. L. Gore v. Garlock, Inc., 721 F.2d. 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion... *[t]he "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation*. This court explained in Zurko, 258 F.3d at 1385, 59 UPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'... "*Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.*"

Similar to the situation in *Lee*, in applying the present rejection, the Office has relied on purported "common knowledge" in drawing motivation solely from the "level of skill in the art." As clearly indicated by the Federal Circuit in *Lee*, this approach is in error.

Applicant submits that the presently claimed invention cannot be obvious over Caine and Kutter in view of the "level of skill in the art." Neither of these references

the art." As clearly indicated by the Federal Circuit in *Lee*, this approach is in error.

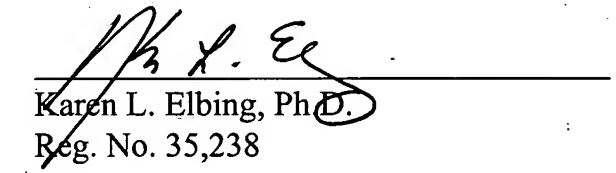
Applicant submits that the presently claimed invention cannot be obvious over Caine and Kutter in view of the "level of skill in the art." Neither of these references disclose or suggest treating a stimulant dependency or cocaine craving by administering pramipexole to a patient either intranasally (claims 15 and 18) or using Applicants' particular dosages (claims 1 and 4). Absent such a suggestion, teaching, or motivation *in the prior art*, no *prima facie* case of obviousness has been established, and the §103(a) rejection should be withdrawn.

## CONCLUSION

Applicant submits that the claims are in condition for allowance, and such action is respectfully requested. Enclosed are a Notice of Appeal and a check in payment of the required fee. Although no charges are believed to be due, if there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 15 October 2003



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